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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,232	08/03/2001	Samuel Sergio Tenenbaum	2875/1G342-US1	7566

7590 06/22/2004

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EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,232

Applicant(s)

TENENBAUM, SAMUEL SERGIO

Examiner

Stephen Gravini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-52, 58-64 and 66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-52, 58-64 and 66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4, 11-16, 21-26, 33-35, 37-43, 45-48, 50-52, 58, 60-63, 65, and 66 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification such that the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same. Those claims contain the features of introducing or displaying a multimedia animated character into a computer screen and selecting a character, greeting, recipient and message. Those features are considered non-enabling because the recited "changing image which appears on screen intrusively in a manner which is unpredictable for a user and which is completely beyond user control" are not claimed such that one skilled in the art would be able to make or use the invention. That recitation claimed is given the broadest reasonable interpretation consistent with the specification, however the recited feature claimed involves subjectivity, which is considered non-enabling to those skilled in the field of endeavor of applicant's invention. The subjective terms "intrusively," "unpredictable," and "completely beyond user control" are interpreted in light of the specification but do not provide full, clear, concise, and exact term limitation such that the claimed invention is enabling. However, in order to

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consider these claims in light of the prior art, examiner will assume that these features are enabling by the specification.

Claims 1-4, 11-16, 21-26, 33-35, 37-43, 45-48, 50-52, 58, 60-63, 65, and 66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Those claims contain the features of introducing or displaying a multimedia animated character into a computer screen and selecting a character, greeting, recipient and message. Those features are considered indefinite because the recited "changing image which appears on screen intrusively in a manner which is unpredictable for a user and which is completely beyond user control" are not claimed such that the features particularly point out and distinctly claim the subject matter which applicant regards as the invention. That recitation claimed is given the broadest reasonable interpretation, however the recited feature claimed involves subjectivity, which is considered indefinite to those skilled in the field of endeavor of applicant's invention. The subjective terms "intrusively," "unpredictable," and "completely beyond user control" are interpreted to many different degrees. What may be intrusive to one might not be so for another (and likewise with respect to unpredictability and user control). However, in order to consider these claims in light of the prior art, examiner will assume that these features are not indefinite by having an antecedent basis from the specification.

Claim Rejections - 35 USC 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-22, 34-47, and 58-64 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese reference 10-222341. That reference is considered to disclose method for modifying an image produced by an application program on the display screen of a computer system, the computer system running the application program under an operating system having a graphical user interface, the method comprising the steps of introducing into the screen a multimedia animated character, said character being introduced so that it appears on the screen intrusively in a manner which is unpredictable for the computer user and which is completely beyond the user's control while the application program is running (paragraph 5), wherein said character moves translationally on the computer screen (paragraph 6), utilized in an operating system which produces multilayer window images on the screen, said character being located in the uppermost layer of the application program window, so that a user cannot move it off the screen or cover it with other objects (also paragraph 6), wherein said character is accompanied by synchronized sound (paragraph 24 wherein the disclose click implies the claimed synchronized sound), wherein the character overlies an existing image produced on the screen by the application program, a portion of the character being transparent, so that a portion of the existing image can be seen therethrough (paragraph 14), wherein the generation of said character is controlled with signals

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stored in a database in response to an exchange of information from the user's computer (paragraph 13), wherein said signals stored in the database define a plurality of said characters which are selected and controlled according to information from the user's computer which is not under the user's control and technical features available in the user's computer and wherein the user's computer is connected to a network, to which there is also connected a character controlling server, in communication with the user's computer, the server having access to the database, said method further comprising the steps of producing a series of instructions executed in the server through an interactive process between the user's computer and the server, to determine a sequence of commands that selects control signals corresponding to one of the characters from said database, and sending the commands to the user's computer for use in introducing the character into the application program image (also paragraph 13), wherein the application program is a browser and the commands are provided to the user's computer within an HTML page being viewed by the user (paragraph 12), wherein the executable code for the character is incorporated in one of installation media and an installation file for the application program, and the executable code is installed at the same time as the application program (paragraph 13), a method for introducing advertising material into multimedia content being viewed by a user over a computer network in which the user's computer is a client running an application program under an operating system having a graphical user interface, the content being received from a content provider's computer acting as a content server, there also being connected to the network a computer operated by a media source acting as a character

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controlling server, the method comprising the steps of: sending content from the content server to the client and providing in the content a tag communicating to the character controlling server; and at the character controlling server, upon being contacted by the client, transferring to the client control signals that will produce on the clients computer display of the content a multimedia animated character, said character being a changing image which appears on the content intrusively in a manner which is unpredictable for the computer user and which is completely beyond the his control (paragraphs 5, 13, and 24), wherein the media source receives payment based upon the number of accesses to a character and the duration of an access (paragraph 12), wherein the information from the user's computer is derived from a cookie stored within the computer (implied at paragraph 15), a method for providing an electronic greeting from a sender to a recipient over a computer network in which the computers of both are clients running an application program under an operating system having a graphical user interface, the greeting being produced by a media source's computer acting as a media server acting as a character controlling server, there also being connected to the network a computer operated by a content provider, the method comprising the steps of: at the senders computer selecting characteristics of the greeting, including a character to present the greeting, the recipient and the message to be sent; at the character controlling server, upon being contacted by the sender, sending to the recipient control signals that will produce on the recipients computer display a multimedia animated character delivering the message, said character being a changing image which appears on the content intrusively in a manner which is unpredictable for

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the recipient and which is completely beyond the his control, the server also providing a signal to the recipient which will call a page provided by the content provider as background to the character and remains after the message is delivered (paragraphs 5, 12, 13, and 24), wherein the media source receives payment from the content provider based upon the number of times the content provider's page is delivered as background to a greeting (paragraph 21), and wherein the HTML page being viewed by the user was received from a content provider's server and the character is introduced therein as a result of tags left in the page by the content provider (paragraph 7).

Claims 23-33, 48-52, and 65-66 are rejected under 35 U.S.C. 102(e) as being anticipated by Baker (US 6,002,401). Baker is considered to disclose a system comprising: a generator of media signals which are configured to produce on the user's display of the application program a multimedia animated character, said character being a changing image which appears on the screen intrusively in a manner which is unpredictable for the computer user and which is completely beyond the user's control; and means for introducing the character to the user's computer display (column 9 lines 35-50), wherein said media signals are configured to produce a character that moves translationally on the computer screen (column 31 lines 21-24), wherein operating system produces multilayered window images on the screen, said media signals being configured to locate the character in the uppermost layer of the application program window, so that a user cannot move it off the screen or cover it with other objects (column 10 lines 25-29), wherein said media signal is configured so that the character is

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accompanied by synchronized sound (column 9 line 58), wherein the media signal is configured so that the character overlies an existing image produced on the screen by the application program and a portion of the character is transparent, so that a portion of the existing image can be seen therethrough (figure 3c), wherein the media signal is generated based upon information stored in a database in response to an exchange of information from the user's computer (column 32 lines 28-67), wherein the information stored in the database defines a plurality of characters, the system further comprising a selector responsive to information from the user's computer which is not under the user's control and technical features available in the user's computer to select media signals corresponding to one of the characters further comprising a connection between the user's computer and a network, a character controlling server also connected to the network in communication with the user's computer, the server having access to the database, said media signal generator being controlled through interactive communication between the user's computer and the server (column 19 lines 15-67), wherein the application program is a browser and the media signals are provided to the user's computer along with an HTML page being processed by the user's computer further comprising content provider's server connected to the network for communication with the user's computer the HTML page being viewed being received from content provider's server, the character being introduced as a result of tags left in the page by the content provider (appendix A implies HTML processing), wherein the generator comprises a computer program that is installed on the user's computer at the same time as the application program from one of installation media and an installation

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file for the application program (column 33 lines 15-40), and wherein said character is completely beyond the user's control while the application is running (column 32 lines 29-67).

Response to Arguments

Applicant's arguments with respect to claims 1-52, 58-64 and 66 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gravini whose telephone number is 703 308 7570. The examiner can normally be reached on normal weekday business hours (east coast time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W Stamber can be reached on 703 305 8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

smg
June 10, 2004

Steve Gravini